

Application no. 09/881,295
Amdt. dated Jan. 20, 2006
Reply to Office Action of Oct. 20, 2005

REMARKS/ARGUMENTS

A. INTRODUCTION

In the Office action of October 20, 2005:

- Claims 7, 9-11, 16, and 18-19 were rejected under 35 USC § 103(a) as being unpatentable over the combination of Elsey et al. (US Application Publication 2002/0055351) and Mittelstadt et al. (US Patent No. 6,389,280);
- Claims 8, 20, and 21 were rejected under 35 USC § 103(a) as being unpatentable over Elsey and Mittelstadt, and further in combination with McCoy et al. (US Patent No. 6,526,575); and
- Claim 17 was rejected under 35 USC § 103(a) as being unpatentable over Elsey and Mittelstadt, and further in combination with Plantec et al. (US Patent 6,826,540).

B. AMENDMENTS TO THE SPECIFICATION

In the specification, the paragraphs [0005] and [0022], and the abstract section have been amended to perform minor editorial, typographical, and/or grammatical corrections. No new matter has been added.

C. REJECTIONS UNDER 35 USC § 103(a)

As to amended claims 7, 9-11, 16, and 18-19, Applicant respectfully submits that the combination of Elsey in view of Mittelstadt is **improper**. Furthermore,

“When applying 35 U.S.C. 103, the following tenets of patent law *must* be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references *must* be considered as a whole and *must* suggest the desirability and thus the obviousness of making the combination;
- (C) The references *must* be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).” (MPEP §2141 35 U.S.C. 103; the Graham Factual Inquiries, emphasis added).

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The Office action states that “[i]t would have been obvious to an artisan at the time of the invention to include Mittelstadt et al.’s teaching with [the] method of Elsey in order to provide [a] user with a calendar system that will configure intelligently instead [of] merely revert[ing] to the existing configuration.” (Office action, page 3, ln. 9). Applicant respectfully submits, however, that nowhere in Elsey or in Mittelstadt does it suggest that these two references be combined and to do so is *impermissible* hindsight. Furthermore, combining the teaching of Mittelstadt and Elsey as suggested by the Examiner as “obvious to an artisan at that time” would result in a calendaring system that defeats the purpose of Elsey, as discussed below. Elsey and Mittelstadt, moreover, are from nonanalogous art.

Applicant respectfully submits that Elsey is “directed to *providing personalized information and communication services to users*, e.g., telephone and mobile device users, especially when they are away from their ‘home’ site from where they normally conduct their business.” (Elsey, para. [0038], first 5 lines, emphasis added). Elsey also discloses “[t]o personalize the services, at least one *profile associated with the user* is used which specifies the subscribed services and the preferred ways of receiving them. For example, the profile may specify use of a special skilled operator, methods of delivery of information to the user, etc.” (Elsey, Abstract, last six lines, emphasis added). The user profile thus contains personalized user information.

Elsey also discloses a calendaring feature wherein a “reminder notification may be communicated to the user via telephone, SMS, email, facsimile, etc. For example, server 28 may cause IVR unit 29 to call the user’s wireless phone number to verbally remind the user of an upcoming appointment.” (Elsey para. [0096] and FIG. 19). FIG. 19, also cited in the Office Action p. 3, shows a new appointment interface enabling a user to enter information about new appointments, particularly a new appointment’s *user-identifying* information such as TITLE, LOCATION, date, and time. This identifying information distinguishes one appointment from the other. If the TITLE is left blank as a default value, for example, it would be difficult for the user to identify and distinguish one appointment from the other. These identifying input fields

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are left blank so that the user may provide *personalized user information*, i.e., by ENTERING the TITLE and LOCATION, via, for example, alphanumeric keyboard entries.

Mittelstadt, on the other hand, relates to a menu system, particularly for a mobile telephone system, wherein in “response to a time-out, the menu logic 511 **reverts to a default menu**, and the configuration logic 112 either continues to use its existing *configuration* or implements a **new configuration based on the menu** in which the time-out occurred.” (Mittelstadt, col. 3 lns. 5-9, FIG. 9, emphasis added). Mittelstadt further explains this by disclosing that the configuration logic after a time out, looks at a logical table and based on the *menu* — not menu option, e.g., hi-lighted menu option — the time out occurred, the corresponding “right column” configuration is implemented. (Mittelstadt, col. 3, lns. 35-55, FIG. 8, and FIG. 9). Thus, Mittelstadt discloses that in response to a time out, the menu logic reverts to a default menu, and based on the menu in which the time-out occurred, a configuration is selected.

Mittelstadt further discloses that a user may affirmatively select a configuration by using the menu options. “FIG. 7 depicts the display 501 displaying menu #2 in response to the selection. Menu #2 includes configuration A and configuration B. The scroll control 503 is used to hi-light one of the configurations, and the selection control 504 is used to select the hi-lighted configuration. For example, the scroll control 503 could be used to hi-light configuration B, and the selection control 504 could be used to select configuration B. The configuration logic 512 would then implement configuration B in response to the menu selection.” (Mittelstadt, col. 3, lns. 19-27). Mittelstadt thus discloses the selection of a configuration via hi-lighting and not by manually entering information such as by entering alphanumeric entries. Mittelstadt therefore does not teach enabling a user to provide user information that is personalized and customizable to the user, e.g., an appointment schedule. The configuration discussed by Mittelstadt is limited to phone operation settings.

The Office Action suggested that FIG. 19 of Elsey may contain pre-filled information, similar to how Mittelstadt has pre-defined configuration information using menus. Applicant respectfully submits, however, that a user may have different types of appointment, different

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manner of identifying appointments, different time and appointment duration, and thus pre-filling FIG. 19 with Mittelstadt's menu option configurations would be impractical and would defeat Elsey's purpose of providing personalized user information. A series of TITLES AND LOCATIONS *with blanks or default values* would not provide useful and personalized user information. Based on the above reasons, the Applicant respectfully submits that the combination of Elsey and Mittelstadt would **NOT** be obvious to those of ordinary skill at that time and thus is an **improper** combination. Furthermore, Elsey relates to a system providing *customizable* user personalized information, while Mittelstadt relates to a phone menu system; thus, they are from nonanalogous art.

If, however, the Examiner is not persuaded with the above arguments, the rejections with regard to amended base claims 7 and 16 are still improper considering that the combination of Mittelstadt and Elsey does not teach the elements of the amended claims. The amended claims are clarified — such that the proxy interface is displayed when a print input selection is received and, when the timer expires, a print task is executed using the print task settings. Mittelstadt at most discloses selecting a configuration or settings, but nowhere does Mittelstadt or Elsey, in combination or individually, teach executing a task, i.e., the print task that uses predetermined or predefined print settings, when the timer expires. Mittelstadt at most teaches selecting a predefined phone operation configuration, but not executing a print task.

Furthermore, as to claim 16, the Office Action states that "Mittelstadt et al. teaches starting a timer when the proxy interface is displayed, and if the timer expires without user input, performing the task using the settings displayed. (see Mittelstadt, column 35-48, figure 8);" (Office Action, pg. 4, lns. 14-16). Applicant respectfully assumes that the Office Action refers to column 3, lns. 35-48 of Mittelstadt, which discusses FIG. 8. The cited Mittelstadt lines state "If the user selects one of the displayed menus, then the menu logic 511 puts the selected menu on the display. The selected menu includes a list of configurations. If the user selects one of the configurations before a time-out occurs, then the configuration logic 512 implements the new configuration. If the time-out logic 513 times-out before a new configuration is selected, then the configuration logic 512 implements the specified configuration for a time-out from

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that menu.” (Mittelstadt, col. 3, lns. 37-45, FIG. 8). Applicant respectfully submits that the Examiner may have misconstrued the cited lines. From the cited lines, Mittelstadt teaches a certain configuration is going to be selected (“implemented”), regardless of whether a time out occurs or not. Applicant respectfully submits that this teaching is not “performing the task using the settings displayed” as stated in the Office Action. Even if read by the Examiner that selecting a configuration is a “task,” it is a *configuration selection task* and not the print task as indicated in the amended claim.

Furthermore, as to claim 10, the Office Action states the “Mittelstadt et. al further teaches the system wherein the predetermined settings are the default settings for the application.” (Office action pg. 3, second to the last paragraph citing Mittelstadt col. 2, ln. 65-col. 3, ln. 8).

Mittelstadt, however, states in those cited lines — “In response to a time-out, the menu logic 511 **reverts to a default menu**, and the configuration logic 112 either continues to use its existing configuration or implements a new configuration based on the menu in which the time-out occurred.” (Mittelstadt, col. 3, lns. 5-9) Applicant respectfully submits that the lines cited by the Examiner, however, indicate a default menu and not settings.

For the above reasons, Applicant respectfully submits that amended base claims 7 and 16 be allowed. As to amended claims 9-11 and 18-19, these claims depend on base claims 7 and 16, respectively, and thus incorporate similar features to that of the base claims with further clarification and/or limitation. Applicant therefore submits that these claims are patentably distinguishable and therefore should also be allowable.

Claims 8, 20, 21 are rejected under 35 USC 103(a) as being unpatentable over Elsey and Mittelstadt and further in view of McCoy. Similar to the above reasons, considering that the combination of Elsey and Mittelstadt is improper, Applicant respectfully submits that the further combination of McCoy is also improper. Moreover, Applicant respectfully submits that amended claims 8, 20, and 21, which depend on the above base claims (claim 7 and 16), incorporate similar features to that of the base claims with further clarification, and thus are patentably distinguishable for the reasons presented above.

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Claim 17 is rejected under 35 USC 103(a) as being unpatentable over Elsey and Mittelstadt and further in view of Plantec. Similar to the above reasons, considering that the combination of Elsey and Mittelstadt is improper, Applicant respectfully submits that the further combination of Plantec is also improper. Moreover, Applicant respectfully submits that amended claim 17, which depends on base claim 16, incorporates similar features to that of the base claim with further clarification, and thus is patentably distinguishable for the reasons presented above.

D. NEW CLAIMS 22-30


Applicant respectfully submits new claims 22-30. Applicant respectfully submits that with the addition of these new claims, no additional search is necessary. No new matter has been introduced and all claims are supported by the Applicant's specification.

E. CONCLUSION

For all the forgoing reasons, Applicant submits that ALL claims be allowed. Furthermore, no new matter has been added by the amendments. No new search is also required. Should there be any other fees due for this action, your office is authorized to draw from the firm deposit account number 023979. Should you have any questions, or identify any problem, I would appreciate a telephone call so that this matter may be resolved promptly.

Respectfully submitted,

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